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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/923,035

08/06/2001

John Nafeh

PA3817US

8962

22830 7590 07/12/2007
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PALO ALTO, CA 94303

EXAMINER

HARBECK, TIMOTHY M

ART UNIT

PAPER NUMBER

3692

MAIL DATE

DELIVERY MODE

07/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/923,035	Applicant(s) NAFEH ET AL.	
	Examiner Timothy M. Harbeck	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-126 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-126 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

DETAILED ACTION

1. This communication is in response to Applicants' Remarks filed on April 10, 2007. In view of Applicants' claims, the election to one of the following inventions is deemed necessary. The restrictions are as stated below:

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group 1: Claims 1-28, 96, 104-105, 113-115, and 124 are drawn to a system and method of conducting business

Group 2: Claims 29-35, 97-102, 106-108, 112, 117-118 and 126 are drawn to a system and method of risk hedging.

Group 3: Claims 36-40 and 109 are drawn to a computer based contract trading system.

Group 4: Claims 41-69, 103, 116, 119-123 and 125 are drawn to a method of conducting business.

Group 5: Claims 70-95, 110 and 111 are drawn to a method of conducting business.

The inventions are distinct, each from the other because Inventions 1-5 are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable.

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In the instant case, each invention has separate utility (See MPEP § 806.05d), specifically demonstrated as follows:

- Invention 1: establishing on said trading system a plurality of separate contracts within contract bundles, each contract bundle paying an aggregate fixed sum at maturity and wherein each contract bundle comprises at least two separate contracts.
- Invention 2: receiving data from a trader identifying a predetermined phenomenon for which a contract bundle is desired, the phenomenon having at least two future possible outcomes at a time of maturity and wherein the contract bundle pays an aggregate fixed sum at maturity
- Invention 3: a contract bundle definition application wherein each contract bundle comprises at least two separate contracts, each separate contract within the contract bundle having an uncertain value based on a future event and each contract bundle having a fixed value payable on the future event
- Invention 4: selling over said trading system, coupons, each coupon for a pre-specified item of value
- Invention 5: establishing on said trading system, a plurality of restricted clientele separate contracts within contract bundles, each contract bundle comprising at least two restricted clientele contracts, each restricted clientele separate contract within the contract bundle having an uncertain value base on a future event and each contract bundle having a fixed value payable on the future event

Because these inventions are distinct for being separately usable, as shown above, examining the inventions together would require searching for a reference teaching the unique element(s) of each invention that are not found in the remaining Inventions. This would be quite burdensome, requiring multiple searches, and thus the restriction for examination purposes, as indicated, is proper.

3. Applicants are advised that the response to this requirement to be complete must include an election of one of the Inventions 1-5 to be examined even though the requirement be traversed.

4. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

5. A shortened statutory period for response to this action is set to expire **0 (zero) months and 30 (thirty) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

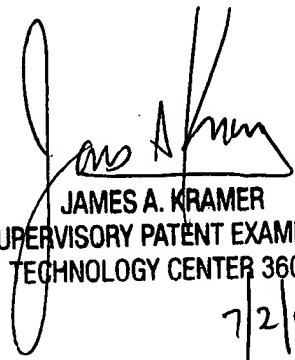
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JAMES A. KRAMER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600
7/2/07